



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

28

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/143,828 08/31/98 BERKENSTAM A 10806-65

┌

HM22/1004

┐

EXAMINER

PAK, M

ART UNIT	PAPER NUMBER
----------	--------------

1646

9

DATE MAILED:

10/04/00

HOLLY D KOZLOWSKI
DINSMORE & SHOHL
1900 CHEMED CENTER
255 EAST FIFTH STREET
CINCINNATI OH 45202

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/143,828

Applicant(s)

Berkenstam et al.

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on Oct 21, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-41 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-41 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, 13-17, and 32-33, drawn to an isolated polynucleotide encoding VDRRg, expression vector, host cell, and method of producing the polypeptide, classified in Class 435, subclass 69.1.

II. Claims 1-9, 13-17, and 32-33, drawn to an isolated polynucleotide encoding VDRRg2, expression vector, host cell, and method of producing the polypeptide, classified in Class 435, subclass 69.1.

III. Claims 10-11, drawn to a nucleic acid probe, classified in Class 536, subclass 24.31.

IV. Claim 12, drawn to a method identifying clones, classified in Class 435, subclass 6.

V. Claims 18-19, 21, 24, and 34, drawn to an isolated VDRRg polypeptide, classified in Class 530, subclass 350.

VI. Claims 18-19, 21, 24, and 34, drawn to an isolated VDRRg2 polypeptide, classified in Class 530, subclass 350.

VII. Claim 20, drawn to a method to produce antibodies, classified in Class 424, subclass 185.1.

VIII. Claim 22, drawn to a method for identifying a ligand to a VDRR polypeptide by a cell based reporter assay, classified

in Class 435, subclass 7.8.

IX. Claim 22, drawn to a method for identifying a ligand by a transgenic animal reporter assay, classified in Class 424, subclass 9.1.

X. Claim 22, drawn to a method for identifying a ligand by a in vitro binding assay, classified in Class 436, subclass 501.

XI. Claim 23, drawn to a method for identifying an agonist, classification could not be determined because the structure of agonist was not provided.

XII. Claim 23, drawn to a method for identifying an antagonist, classification could not be determined because the structure of agonist was not provided.

XIII. Claim 29, drawn to a method for treating by administering nucleic acid vectors, classified in Class 514, subclass 44.

XIV. Claims 30-31 and 35-41, drawn to a method for treatment by administering substance, classification could not be determined because the structure of substance was not provided.

The inventions are distinct, each from the other because of the following reasons.

The products of inventions I-III and V-VI, are distinct each from the other, because they are drawn to products having materially different structures and functions.

The methods of inventions IV and VII-XIV, are distinct, each

from the other, because they are drawn to processes having materially different process steps, which are practiced using different materials.

Inventions of products of Group I-III, and the methods of Groups IV and XIII are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced alternatively with any one of the product of Group I-III. The product as claimed can be used in a materially different process of alternatively Group IV or XII.

The products of inventions I-III are not used in or produced by the process of inventions VII-XII or XIV, and is distinct from each other.

Inventions of products of Group V and VI, and the methods of Group VII-XII are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In

the instant case the product as claimed can be used in a materially different process of alternatively of Groups VII-XII. The process for using the product as claimed can be practiced with alternatively the product of Group V or VI.

The products of inventions V-VI are not used in or produced by the process of inventions IV, XIII or XIV, and is distinct from each other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Serial Number: 09/143,828
Art Unit: 1646

Page 6

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 5:50 AM to 2:20 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D. Pak

Michael Pak
Primary Patent Examiner
Art Unit 1646
25 September 2000